

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Corey J. Norris

Confirmation No.: 1510

Application No.: 09/976,533

Examiner: Chilcot, Richard

Filing Date: 10/11/2001

Group Art Unit: 3627

Title: EMBEDDED PAYMENT FOR MOBILE PRINTING

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 12/02/2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

**(complete (a) or (b) as applicable)**

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

( ) one month	\$120.00
( ) two months	\$450.00
( ) three months	\$1020.00
( ) four months	\$1590.00

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Corey J. Norris

By Mark G. Pannell

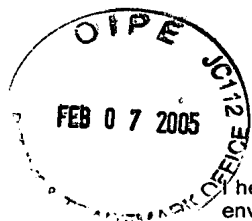
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**PATENT APPLICATION**  
**ATTORNEY DOCKET NO. 10011776-1**

**IN THE**  
**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Title:** Embedded Payment for Mobile Printing

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**Commissioner For Patents**  
**Alexandria, VA 22313-1450**

**APPELLANT'S APPEAL BRIEF**

**Sir:**

**REAL PARTY IN INTEREST**

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

**RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences which will directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

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## STATUS OF CLAIMS

Claims 1-20 have been rejected and are appealed.

## STATUS OF AMENDMENTS

The amendment filed on 08/02/2004, subsequent to final rejection, has been entered.

## SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed subject matter of each of the independent claims relates to transferring an electronic document 12 from a mobile computer 4 to print media in exchange for payment. An output apparatus 6, separate from the mobile computer, includes components for making the transfer to print media and the payment transaction. (Fig. 1, p. 3, ¶ [0016] – p. 5, ¶ [0025]).

The output apparatus 6 discovers 44 payment account information from the separate mobile computer 4. A point of service terminal 16 is the component of output apparatus 6 that discovers 44 the payment account information. (Figs. 1-2, p. 4, ¶ [0017]-[0018], p. 6, ¶ [0027]).

The output apparatus 6 accepts 50 the electronic document 12, from the separate mobile computer 4, as electronic document 42. A communication interface 18 is the component of output apparatus 6 that accepts 50 the electronic document 12. (Figs. 1-2, p. 4, ¶ [0019]-[0020], p. 6, ¶ [0030]).

The electronic document 42 is transferred 52 to print media. A transcriber within output apparatus 6 transfers 52 the electronic document 42 onto the print media. (Figs. 1-2, p. 5, ¶ [0022], p. 6, ¶ [0031]).

The output apparatus 6 determines 54 a price for accepting the electronic document 12 and transferring the electronic document 42 to print media. A tabulator 22 of the output apparatus 6 determines 54 the price. (Figs. 1-2, p. 5, ¶ [0023], p. 6, ¶ [0031]).

A payment transaction is executed 56 with the payment information, at the determined price. An invoicer 24 is the component of the output apparatus 6 that

executes 56 the payment transaction. (Figs. 1-2, p. 5, ¶ [0024], p. 6, ¶ [0032]).

The configuration of Applicant's invention and claims allows a user with a mobile computer to print an electronic document from an output apparatus equipped as claimed by Applicant. The user provides payment account information to the output apparatus and transmits the electronic document to the output apparatus. The output apparatus then transfers the electronic document to print media, determines a price, and executes a payment transaction.

#### GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-20, as a group, have been rejected under 35 U.S.C. §103(a) as being unpatentable over Otsuka et al., U.S. Patent No. 6,201,771, alone.

#### ARGUMENT

##### **Whether claims 1-20 are unpatentable under 35 U.S.C. §103(a) over Otsuka et al., US 6,201,771, alone**

As to a rejection under 103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The Examiner states that Otsuka discloses every element of each of

Applicant's rejected claims except that the computer in Otsuka is not disclosed to be a mobile computer. The Examiner also states that mobile computers are well known and that it would be obvious to one skilled in the art that the computer used in Otsuka could be mobile.

However, the Applicant disagrees, in that the Otsuka reference does not teach or suggest all of Applicant's claim limitations, and there is no suggestion or motivation to modify the reference.

**The Otsuka reference does not teach or suggest all of Applicant's claim limitations**

**The Otsuka Patent (6,201,771)**

Otsuka discloses a content providing system for providing or selling a recording medium onto which desired content such as an electronic version of a newspaper or a magazine has been loaded. (Col. 1, line 55 - col. 2, line 3 and col. 5, lines 49-50). Information providing apparatuses 1 are disposed at places where people can use them, such as stores, stations, schools, and businesses. (Col. 1, line 67 - col. 2, line 3). As described here and throughout Otsuka, Otsuka discloses a system for providing content to the public or at least some section of the public.

The user selects, from an information providing apparatus 1, content to be downloaded (copied) onto a recording medium, such as a computer disk. The user then pays for the content, and the selected content is copied to the recording medium. Either the information providing apparatus 1 or the user may supply the recording medium. (Figs. 7A-C and col. 14, line 53 – col. 16, line 65).

If the information providing apparatus 1 supplies the recording medium, the fee charged to the user may include a fee for the recording medium. Otherwise, if the medium is provided by the user, the fee charged to the user is for the content. (Col. 7, lines 11-28). The user may pay the fee by various means, including credit card payment. In the case of payment by credit card or by other means including payment account information, information providing apparatus 1 accepts the payment account information from the user. (Col. 6, line 35 – col. 7, line 10).

Information providing apparatus 1 includes a computer 20 for carrying out processing functions. The computer 20 includes a hard disk drive (HDD) 21 for internal storage. (Col. 11, lines 55-67). Information providing apparatus 1 may also include a printer portion or be connected to a printer for providing printer output. (Col. 14, lines 21-26).

After payment of the fee, the computer 20 supplies the content from its HDD 21 and loads the content to the recording medium. (Col. 13, lines 10-14; col. 18, lines 11-15; col. 20, lines 6-11; col. 21, lines 11-15; and col. 28, lines 60-64). The loaded recording medium is then provided to the user.

#### Applicants' Invention vis-à-vis Otsuka

Applicants' invention is an apparatus and method for transferring an electronic document from a mobile computer to print media in exchange for payment. An output apparatus, separate from the mobile computer, discovers payment account information. The output apparatus then accepts the electronic document from the separate mobile computer and the electronic document is transferred to print media. The output apparatus determines a price for accepting the electronic document and transferring the electronic document to print media and a payment transaction is executed with the payment information, at the determined price.

This sharply contrasts with Otsuka where the output apparatus is either not separate from the computer or does not accept payment information. Additionally, there is no price disclosed in Otsuka for accepting the electronic document. Furthermore, the output apparatus of Otsuka either is not separate from the computer, or does not determine the price.

#### The output apparatus is either not separate from the computer or does not accept payment information

Even should the computer 20 of Otsuka be replaced by a mobile computer, Otsuka clearly does not disclose limitation (a) of Applicant's independent claims 1, 8, and 15. For claims 1 and 15, (a) recites, "an output

apparatus, separate from the mobile computer, discovering payment account information."

Otsuka discloses that the information providing apparatus 1 discovers payment account information. The information providing apparatus 1 includes a computer 20 having a HDD 21 on which an electronic document is stored. The information providing apparatus may also include a printer portion or be connected to a printer for providing printer output.

Otsuka may be interpreted in two ways related to (a) of Applicant's claims 1 and 15. In one interpretation, the information providing apparatus 1 is an output apparatus. Otsuka discloses the information providing apparatus 1 discovering payment account information. However, since the computer 20 is a part of the information providing apparatus 1, the information providing apparatus 1 is not separate from the computer 20.

In another interpretation, the connected printer is the output apparatus. The connected printer may be separate from the computer 20. However, it is the information providing apparatus 1 and not the connected printer that discovers the payment account information.

Depending on which portion of the system of Otsuka is interpreted to be the output apparatus, either the output apparatus is not separate from the computer 20 or the output apparatus does not discover payment account information. Therefore, Otsuka does not disclose an output apparatus, separate from the computer 20, discovering payment account information.

Applicant's claim 8 is directed to an output apparatus having, "(a) a point of service terminal separate from the mobile computer, the point of service terminal configured to discover payment account information." Again, Otsuka may be interpreted in two ways. In one interpretation, the information providing apparatus 1 is the output apparatus having the point of service terminal, but the computer 20 is not separate from the information providing apparatus 1. In another interpretation, the connected printer is the output apparatus, but the printer does not include a point of service terminal configured to discover the payment account information.

There is no price disclosed for accepting the electronic document

Furthermore, even should the computer 20 of Otsuka be replaced by a mobile computer, Otsuka clearly does not disclose limitation (d) of Applicant's independent claims 1, 8, and 15. For claims 1 and 15, (d) recites, "the output apparatus determining a price for accepting the electronic document and transferring the electronic document to print media." Applicant's claim 8 is directed to an output apparatus having, "(d) a tabulator separate from the mobile computer, the tabulator configured to determine a price for accepting the electronic document and transferring the electronic document to print media."

Whether the information providing apparatus 1 or a connected printer is interpreted as the output apparatus, Otsuka does not disclose any output apparatus or any component thereof determining a price for accepting an electronic document. The electronic document of Otsuka is provided by the information providing apparatus 1 and Otsuka does not disclose the connected printer determining a price for anything. Therefore, should the connected printer be considered the output apparatus of Applicant's claims, neither the output apparatus nor any component thereof would determine a price.

Should the information providing apparatus 1 be considered the output apparatus of Applicant's claims, there is no transfer of the electronic document and, thus, no acceptance of the electronic document. Where there is no acceptance of the electronic document, there can be no fee determined for accepting the electronic document.

The output apparatus either is not separate from the computer, or does not determine the price

Furthermore, Applicant's claim 8 requires that the tabulator of the output apparatus be separate from the mobile computer. Should the information providing apparatus 1 of Otsuka be considered the output apparatus of Applicant's claim 8, Otsuka fails to disclose the tabulator being separate from the computer 20. Should the connected printer of Otsuka be considered the output



apparatus of Applicant's claim 8, Otsuka fails to disclose the output apparatus having a tabulator configured to determine a price for accepting an electronic document. Under either interpretation of Otsuka, Otsuka fails to disclose (d) of Applicant's claim 8.

The Examiner further states that it would be obvious to one skilled in the art that various components of a device could be contained in an integral unit or divided into separate units assigned functions as desired. While components can be moved, rearranging components and assigning different tasks to the components such that the entire purpose of a device is changed would not be obvious.

The device disclosed by Otsuka is a system for allowing the public to obtain a recording medium such as a floppy disc or a CD-ROM onto which desired content has been downloaded. The desired content described in Otsuka is supplied by the Otsuka system itself. This is quite different from Applicant's invention as embodied in Applicant's independent claims 1, 8, and 15. Applicant's invention is an output apparatus for use with a mobile computer for printing a document. The document is supplied by the mobile computer of the user. Payment account information is provided to the output apparatus, the document is transferred between the mobile computer and the output apparatus, the document is printed, the output apparatus determines a price, and a payment transaction is executed.

In Applicant's claimed invention, it is recited that the output apparatus be separate from the mobile computer, that the output apparatus receive the electronic document, and that the output apparatus determine the price. This provides the advantage of allowing a user of a mobile computer to approach Applicant's output apparatus, provide payment account information to the output apparatus, transfer an electronic document to the output apparatus, and receive a printed copy of the document in exchange for payment. These limitations are reflected very clearly in Applicant's independent claims 1, 8, and 15.

The device of Otsuka cannot accomplish this same type of transaction, even should the computer be replaced with a mobile computer. The apparatus of Otsuka merely provides information on a recording medium to a user – information that the apparatus, not the user, supplies. Replacing the computer 20 with a mobile computer does not change this function. Neither does rearranging the components of the apparatus of Otsuka. The apparatus of Otsuka cannot operate as can Applicant's output apparatus as recited in Applicant's independent claims 1, 8, and 15.

**There is no suggestion or motivation to modify the Otsuka reference**

Furthermore, as specifically explained in the MPEP 706.02(j), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. There is no suggestion or motivation in Otsuka or generally available to one of ordinary skill in the art to modify Otsuka by replacing the computer with a mobile computer. In fact, Otsuka clearly teaches away from such a suggestion.

Otsuka discloses "a content providing system in which many unspecified people arbitrarily use it to obtain (purchase) a recording medium in which desired content has been downloaded." (Otsuka col. 1, line 67 - col. 2, line 3). As described here and throughout Otsuka, Otsuka discloses a system for providing content to the public or at least some section of the public. Such systems may be disposed at "a store, a station, a school, a company" (Otsuka col. 5, lines 25-27).

Having a mobile computer in place of the computer of Otsuka would suggest that the computer be intended to be moved about and taken from place to place by someone. This is clearly not the intended use of the system of Otsuka. It is clearly the intended use of Otsuka that the computer be stationary within the apparatus of Otsuka, so as to be useful to the apparatus and accessible by the public. Having a mobile computer in place of the computer in Otsuka would defeat the purpose of the system of Otsuka. Therefore, it would not be obvious to one skilled in the art to replace the computer of Otsuka with a


mobile computer.

#### CONCLUSION

Otsuka fails to disclose every element of each of Applicant's rejected claims, even should the computer of Otsuka be replaced by a mobile computer. Not only is this evident by applying the claim language of Applicant's claims to Otsuka, but it is also clear when the function and purpose of Applicant's invention, as enabled by the specific wording of Applicant's claims, is compared to what is disclosed by Otsuka. Furthermore, replacing the computer of Otsuka with a mobile computer is contrary to the teaching of Otsuka. Each of these reasons alone distinguishes Applicant's claims from Otsuka and makes Applicant's claims non-obvious in light of Otsuka.

Overruling of the Examiner's rejections of claims 1-20 is respectfully requested.

Respectfully submitted,  
Corey J. Norris

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## APPENDIX: CLAIMS

1. A method for transferring an electronic document from a mobile computer to print media in exchange for payment, the method comprising:

(a) an output apparatus, separate from the mobile computer, discovering payment account information;

(b) the output apparatus accepting an electronic document from the separate mobile computer;

(c) transferring the electronic document to print media;

(d) the output apparatus determining a price for accepting the electronic document and transferring the electronic document to print media; and,

(e) executing a payment transaction with the payment information, at the determined price.

2. The method of claim 1 wherein discovering the payment account information includes reading the payment account information from an encoded strip selected from the group consisting of a magnetic strip and an optical strip.

3. The method of claim 1 wherein discovering the payment account information includes receiving a transmission including the payment account information.

4. The method of claim 1 wherein accepting an electronic document

includes receiving a transmission including the electronic document.

5. The method of claim 1 wherein determining a price for receiving and transferring the electronic document includes:

- (a) counting a number of pages of the electronic document; and,
- (b) multiplying the number of pages by a price per page

6. The method of claim 1 further including verifying the payment account information.

7. The method of claim 1 further including responsive to discovering the payment account information, activating the output apparatus to accept the electronic document and transfer the electronic document to print media.

8. An output apparatus for transferring an electronic document from a mobile computer to print media in exchange for payment, the system comprising:

- (a) a point of service terminal separate from the mobile computer, the point of service terminal configured to discover payment account information;
- (b) a communication interface configured to accept an electronic document from the separate mobile computer;
- (c) a transcriber configured to transfer the electronic document to print media;
- (d) a tabulator separate from the mobile computer, the tabulator

configured to determine a price for accepting the electronic document and transferring the electronic document to print media; and,

(e) an invoicer configured to execute a payment transaction with the payment information, at the determined price.

9. The output apparatus of claim 8 wherein the point of service terminal includes a strip reader configured to read the payment account information from an encoded strip selected from the group consisting of a magnetic strip and an optical strip.

10. The output apparatus of claim 8 wherein the point of service terminal includes a receiver configured to receive a transmission including the payment account information.

11. The output apparatus of claim 8 wherein the communication interface includes a receiver configured to receive a transmission including the electronic document.

12. The output apparatus of claim 8 wherein the tabulator includes:

(a) a monitor configured to count a number of pages of the electronic document; and,

(b) a calculator configured to multiply the number of pages by a price per page

13. The output apparatus of claim 8 further including an authenticator configured to verify the payment account information.

14. The output apparatus of claim 8 further including an initializer configured to respond to discovering the payment account information by activating the output apparatus to accept the electronic document and transfer the electronic document to print media.

15. A program storage system readable by a computer, tangibly embodying a program, applet, or instructions executable by the computer to perform method steps for transferring an electronic document from a mobile computer to print media in exchange for payment, the method steps comprising:

(a) an output apparatus, separate from the mobile computer, discovering payment account information;

(b) the output apparatus accepting an electronic document from the separate mobile computer;

(c) the output apparatus transferring the electronic document to print media;

(d) the output apparatus determining a price for accepting the electronic document and transferring the electronic document to print media; and,

(e) the output apparatus executing a payment transaction with the payment information, at the determined price.

16. The program storage system of claim 15 wherein the method step of discovering the payment account information includes reading the payment account information from an encoded strip selected from the group consisting of a magnetic strip and an optical strip.

17. The program storage system of claim 15 wherein the method step of discovering the payment account information includes receiving a transmission including the payment account information.

18. The program storage system of claim 15 wherein the method step of accepting an electronic document includes receiving a transmission including the electronic document.

19. The program storage system of claim 17 wherein the method steps further include verifying the payment account information.

20. The program storage system of claim 15 wherein the method steps further include responsive to discovering the payment